Paper No. _____

Filed on behalf of Akorn Inc.
By: Michael R. Dzwonczyk
Azy S. Kokabi
Travis B. Ribar
Sughrue Mion, PLLC
2100 Pennsylvania Ave., NW
Washington, DC 20037
Telephone: 202-293-7060
Facsimile: 202-293-7860
email: mdzwonczyk@sughrue.com
akokabi@sughrue.com
tribar@sughrue.com

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AKORN INC.
Petitioner

v.

ALLERGAN, INC.
Patent Owner

Case No. IPR2017-00598
Patent No. 8,642,556

MOTION FOR JOINDER

Table of Contents

I. Statement of precise relief requested 1

II. Statement of material facts 2

III. Applicable legal standard 3

IV. Argument 4

A. Joinder is timely 4

B. Joinder is appropriate because both IPRs present the same grounds of unpatentability concerning the same claims of the same patent 5

C. Joinder is appropriate because the Akorn IPR proposes no additional grounds of unpatentability 6

D. Joinder will not impact the existing trial schedule 6

E. Joinder will simplify briefing and discovery 6

V. Conclusion 7

CERTIFICATE OF SERVICE 9

I. STATEMENT OF PRECISE RELIEF REQUESTED

Petitioner Akorn, Inc. ("Akorn") requests joinder and/or consolidation of its today-filed Petition ("the Akorn Petition") for *inter partes* review of U.S. Patent No. 8,642,556 ("the '556 Patent") ("the Akorn IPR") with IPR2016-01129, filed June 3, 2016 by Mylan Pharms. Inc. ("the Mylan IPR"). The Mylan IPR was instituted on December 8, 2016. *Mylan Pharm., Inc. v. Allergan, Inc.*, IPR2016-01129, slip op. at 24-25 (PTAB December 8, 2016) (Paper 8).

The Akorn Petition is substantially the same as the Petition in the Mylan IPR. The Akorn Petition involves the same patent, the same claims, and presents the same grounds of unpatentability, using the same evidence, as the Petition in the Mylan IPR, except where Akorn-specific substitutions were required. The Akorn IPR challenges the claims as anticipated and/or obvious over the same prior art, based on the same arguments, and relies on the same expert, Dr. Mansoor Amiji as the Mylan IPR. Indeed, Mylan has consented to Akorn's retention of Dr. Amiji for purposes of the Akorn IPRs.

Joinder is appropriate because the Akorn IPR Petitioner will take on a purely understudy role in the Mylan IPR, and thus joinder will not cause any delay in the Mylan IPR trial schedule. Mylan Pharms., Inc., the Petitioner in the Mylan IPR, is

not opposing this joinder, and joinder will not prejudice any of the parties to the Mylan IPR.

II. STATEMENT OF MATERIAL FACTS

1. On June 3, 2016, Mylan filed a Petition for *Inter Partes* Review ("the Mylan Petition") of claims 1-20 of U.S. Patent No. 8,642,556. The Mylan IPR was accorded Case No. IPR2016-01129.

2. The Mylan Petition asserted the following grounds of unpatentability:

a. Ground 1: Claims 1-20 are anticipated under § 102 by Ding '979;

b. Ground 2: Claims 1-20 are obvious under §103 overDing '979 and Sall;

c. Ground 3: Claims 14 and 19 are obvious under §103 over Ding '979, Sall, and Glonek;

d. Ground 4: Claims 11, 18, and 20 are obvious under §103 over Ding '979, Sall, and Acheampong; and

e. Ground 5: Claim 19 is obvious under §103 over Ding '979, Sall, Glonek, and Acheampong.

3. On December 8, 2016, the PTAB granted the Mylan Petition on all of the asserted grounds of unpatentability. *Mylan Pharm., Inc. v. Allergan, Inc.*, IPR2016-01129, slip op. at 24-25 (PTAB December 8, 2016) (Paper 8).

4. Akorn filed a Petition for *Inter Partes* Review on January 6, 2017, Case No. IPR2017-00598, and filed the present Motion for Joinder the same day.

5. The Petition in the Akorn IPR is substantially identical to the Petition in the Mylan IPR and includes substantially the same exhibits and relies on the same expert as the Petition in the Mylan IPR.

III. APPLICABLE LEGAL STANDARD

An *inter partes* review may be joined with another *inter partes* review, subject to the provisions 35 U.S.C. § 315(c), which governs joinder of *inter partes* review proceedings:

> (c) JOINDER. — If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). The PTAB has indicated that a

motion for joinder should set forth the reasons joinder is appropriate, identify any new grounds of unpatentability asserted in the petition, and explain what impact (if any) joinder would have on the trial schedule for the existing review. *See Kyocera Corp. v. Softview, LLC,* Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

IV. ARGUMENT

A. Joinder is timely

Akorn's request for joinder is timely because it was filed on January 6, 2017, which is less than one month after the December 8, 2016 institution of the Mylan IPR. This Motion for Joinder is therefore filed "no later than one month after the institution date of any *inter partes* review for which joinder is requested." 37 C.F.R. § 42.122(b).

Furthermore, the Petition for *Inter Partes* Review filed concurrently with the present Motion for Joinder is not time barred under 37 C.F.R. § 42.101(b) because "[t]he time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder." *Id.*

B. Joinder is appropriate because both IPRs present the same grounds of unpatentability concerning the same claims of the same patent

Joinder is appropriate here because Akorn has presented the same arguments in the Akorn Petition as are present in the Mylan Petition. In particular, both the Akorn and the Mylan Petitions allege the same three grounds of unpatentability:

a. Ground 1: Claims 1-20 are anticipated under § 102 by Ding '979;

b. Ground 2: Claims 1-20 are obvious under §103 over Ding '979 and Sall;

c. Ground 3: Claims 14 and 19 are obvious under §103 over Ding '979, Sall, and Glonek;

d. Ground 4: Claims 11, 18, and 20 are obvious under §103 over Ding '979, Sall, and Acheampong; and

e. Ground 5: Claim 19 is obvious under §103 over Ding '979, Sall, Glonek, and Acheampong.

Furthermore, the Akorn Petition is substantially identical to the Mylan Petition. The Akorn Petition contains the same arguments as the Mylan Petition and relies upon the same expert testimony and exhibits, except where Akorn-specific substitutions were required.

Thus, the parties in both the Akorn and Mylan IPRs will be presenting the same arguments, and the PTAB will be considering the same issues, in both IPRs. Joinder is therefore the most just, speedy, and inexpensive way in which to proceed. *See* 37 C.F.R. § 42.1(b).

C. Joinder is appropriate because the Akorn IPR proposes no additional grounds of unpatentability

As indicated above, there are no grounds of unpatentabilty presented in the Akorn Petition that were not presented, and accepted for the purposes of institution, in the Mylan Petition.

D. Joinder will not impact the existing trial schedule

Akorn will not request any alterations to the schedule in the Mylan IPR. In addition, because joinder will not introduce any new prior art, arguments, or grounds of unpatentability into the Mylan IPR, joining the Akorn and Mylan IPRs will not complicate the substantive issues already pending in the Mylan IPR.

E. Joinder will simplify briefing and discovery

To simplify briefing and discovery, the petitioners in the Akorn IPR will adopt an "understudy role" in the joined proceedings. So long as the petitioners in the Mylan IPR ("Mylan") remain a party in the Mylan IPR, the petitioners in the Akorn IPR agree to consolidated filings for all substantive papers in the respective

proceedings, except for motions that do not involve Mylan. The petitioners in the Akorn IPR also agree that cross-examinations will occur within the timeframe normally allotted by the rules to one party and will not need to be extended in light of the joinder. Furthermore, unless Mylan ceases to be a party in the IPR, the petitioners in the Akorn IPR agree that oral argument will be conducted by Mylan.

Accordingly, joinder will greatly simplify the proceedings, and neither the Board, the patent owner, nor Mylan will be prejudiced by joinder, given the present petitioners' willingness to be an "understudy" in the joined proceeding.

To this end, Petitioner notes that the PTAB has granted joinder in similar circumstances before. In particular, in IPR2016-01665, Petitioner Amerigen Pharmaceuticals Limited was granted joinder with a previously-filed IPR by Mylan Pharmaceuticals, Inc. where the petitioner made many of the concessions noted above. *Amerigen Pharm. Ltd. v. UCB Pharma GMBH*, IPR2016-01665, slip op. at 4-7 (PTAB December 7, 2016) (Paper No. 26).

V. CONCLUSION

For the foregoing reasons, the present petitioners respectfully request that the Board institute the Petition for *Inter Partes* Review submitted concurrently herewith, and join this proceeding with *Mylan Pharmaceuticals Inc. v. Allergan, Inc.*, Case IPR2016-01129.

Respectfully submitted,

/ Azy S. Kokabi /

Michael R. Dzwonczyk, Reg. No. 36,787
Azy S. Kokabi, Reg. No. 58,902
Travis B. Ribar, Reg. No. 61,446

SUGHRUE MION, PLLC
2100 Pennsylvania Ave., N.W., Suite 800
Washington, D.C. 20037-3202
Telephone: (202) 293-7060
Facsimile: (202) 293-7860
Dated: January 6, 2017

CERTIFICATE OF SERVICE

(37 C.F.R. §§ 42.6(e) and 42.105(a))

The undersigned hereby certifies that the above-captioned "**MOTION FOR JOINDER**" was served on Patent Owner, on this 6th day of January, 2017, on the Patent Owner at the correspondence address of the Patent Owner as follows:

ALLERGAN, INC.
2525 Dupont Drive, T2-7H
Irvine, CA 92612-1599

and at other addresses also likely to affect service:

Jonathan E. Singer
FISH & RICHARDSON P.C.
60 South Sixth Street, #3200
Minneapolis, MN 55402
(612) 335-5070

Respectfully submitted,

/ Azy S. Kokabi /
Michael R. Dzwonczyk, Reg. No. 36,787
Azy S. Kokabi, Reg. No. 58,902
Travis B. Ribar, Reg. No. 61,446

SUGHRUE MION, PLLC
2100 Pennsylvania Ave., N.W., Suite 800
Washington, D.C. 20037-3202
Telephone: (202) 293-7060
Facsimile: (202) 293-7860
Dated: January 6, 2017